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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/120,664	07/22/1998	DAVID F. GAVIN	101792-100	2454

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WIGGIN AND DANA LLP
ATTENTION: PATENT DOCKETING
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EXAMINER	
GROSS, CHRISTOPHER M	
ART UNIT	PAPER NUMBER
1639	

MAIL DATE	DELIVERY MODE
09/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/120,664	GAVIN ET AL.	
	Examiner	Art Unit	
	CHRISTOPHER M. GROSS	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/27/2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,38,40-42 and 46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,38,40-42 and 46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Responsive to communications entered 6/27/2008. Claims 1,38,40,41,42,46 are pending. Claims 1,38,40,41,42,46 are examined herein.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/27/2008 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

This application has a filing date of 7/22/1998. Applicant makes no claim for the benefit of any prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c).

Withdrawn Rejection(s) and Objection(s)

The objection to the specification is hereby withdrawn in view of applicant's amendments to the abstract.

The rejection of claims 42 and 46 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention concerning new matter is hereby withdrawn in view of applicant's amendments to the claims.

The rejection of claims 1, 38, 42 under 35 U.S.C. 102(e) as being anticipated by Hani et al. US Pat. No. 6,162,446 (12/00: filed 3/98) is hereby withdrawn in view of applicants' amendments to the claims.

The rejection of claims 1, 38, 42 under 35 U.S.C. 102(e) as being anticipated by Mohseni et al. US Pat. No. 6,465,015 (10/02: filed 2/98) is hereby withdrawn in view of applicant's amendments to the claims.

Maintained Claim Rejection(s) - 35 USC § 102

Claims 1, 38, 40, 41, 42, 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Morris US Pat. No. 5,916,947 (6/99: filed 9/96 or earlier).

Response to Arguments

On p 7 of applicants' remarks entered 6/27/2008, applicant argues that the particles of present invention differs from those of Morris et al in that the zinc pyrithione shell and zinc oxide core are held together by physical forces whereas the present invention utilizes a transchelation chemical reaction of the zinc oxide core with a pyrithione salt or acid to form a zinc pyrithione shell.

In this vein, the examiner submits, as mentioned in the last office action, preparing the claimed particles by a physical process, such as set forth by Morris et al versus the chemical process of the present invention represents a product-by-process limitation.

As set forth in MPEP § 2113, "'[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the

product itself. **The patentability of a product does not depend on its method of production**. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.' *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)." Here, Applicants' claims are drawn to a biocidal compostion (i.e., a product), but are defined by various method steps that produce said biocide and, as a result, represent product-by-process claims. Thus, the process limitations do not appear to provide any patentable weight to the claimed invention in accordance with MPEP § 2113. *One of ordinary skill would expect the product to be the same no matter how it was synthesized and/or prepared.*

Furthermore, according to MPEP 2112.01, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, **the applicant has the burden of showing that they are not.**" In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Emphasis added. And, as a practical matter, **the Patent Office is not equipped to manufacture** products by the myriad of processes put before it and then obtain prior art products **and make physical comparisons therewith**." In re Brown, 459 F.2d 531, 535,173 USPQ 685, 688 (CCPA 1972). Emphasis added.

Thus, the examiner most respectfully submits the PTO has sound basis for believing that the particles of applicant and the prior art according to Morris et al are the same and applicant has not presented any evidence on the record regarding any physiochemical or functional differences between the claimed subject matter and the particle described by Morris et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

cg

/JD Schultz, PhD/

Supervisory Patent Examiner, Art Unit 1635